



UNITED STATES PATENT AND TRADEMARK OFFICE

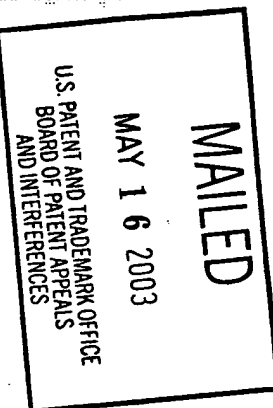
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

WASHINGTON, DC 20231

www.uspto.gov

DAVID P. GORDON
65 WOODS END ROAD
STAMFORD, CT 06905

Paper No: 21
Appeal No: 2003-1371
Appellant: GORDON, MERYL GREENWALD
Application: 09/186,856



**Board of Patent Appeals and Interferences
Docketing Notice**

Application 09/186,856 was received from the Technology Center at the Board on April 21, 2003 and has been assigned Appeal No: 2003-1371.

A review of the file indicates that the following documents have been filed by appellant:

Appeal Brief filed on: June 17, 2002
Reply Brief filed on: November 13, 2002
Request for Hearing filed on: None

In all future communications regarding this appeal, please include both the application number and the appeal number.

The mailing address for the Board is:

**BOARD OF PATENT APPEALS AND INTERFERENCES
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231**

The facsimile number of the Board is 703-308-7952. Because of the heightened security in the Washington D.C. area, facsimile communications are recommended. Telephone inquiries can be made by calling 703-308-9797 and should be directed to a Program and Resource Administrator.

By order of the Board of Patent Appeals and Interferences

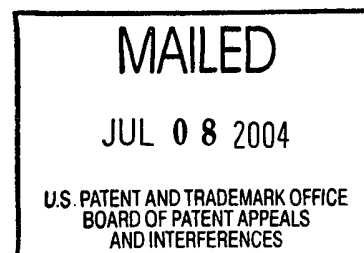
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MERYL GREENWALD GORDON and DAVID P. GORDON

Appeal No. 2003-1371
Application No. 09/186,856

ON BRIEF



Before KRASS, RUGGIERO, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-21. The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm-in-part.

BACKGROUND

The invention at issue on appeal is a computer game for simultaneous play by colocated girls. With the ubiquity of desktop computers, computer games have become a source of entertainment for children. Many of the original computer games were designed for single players. More recently, computer games such as Acrophobia by

Berkley Systems have allowed multiple players to compete via the Internet. (Spec. at 1.)

The appellants opine that the market for computer games is driven by action games that attract boys. To date, they add, most commercially successful computer games have been written for, and marketed to, boys. (*Id.*)

In contrast, the appellants' computer game requires its two players to act cooperatively (and independently) to complete the game. Different modes of cooperation are provided within the context of a story and include holding a door for a player, handing a tool to a player, and helping a player lift an object. Furthermore, both players must complete the game together; neither player can complete the game without the other. (*Id.* at 47.) The appellants believe that such cooperation "is necessary for the success of a girl-directed computer game." (*Id.* at 8.)

A split-screen mode and a single-screen mode enhance the difference between cooperative action and independent action. When players are cooperating, the single-screen mode is generally used; when players are acting independently, the split-screen mode is generally used. (*Id.* at 47.) The appellants believe that the modes, which allow close interaction between players, will appeal to girls. (*Id.* at 13.)

A further understanding of the invention can be achieved by reading the following claim.

1. A multiplayer electronic adventure game for use with a processing apparatus having a graphical display and input means for receiving input from at least two players simultaneously, said adventure game comprising:

a) player location means for associating a game location with each player such that as each player moves through said adventure game, each player's game location is updated; and

b) split screen means for dividing the graphical display into separate portions of each player, said split screen means being responsive to said player location means such that when two players' game locations are within a preset range, the separate portions of the graphical display for the two players are merged into a single portion of the graphical display, and when the two players' game locations are outside the preset range, the graphical display for the two players is split into separate portions.

Claims 1-18, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,405,151 ("Naka") and either U.S. Patent No. 5,080,377 ("Stamper") or U.S. Patent No. 5,354,063 ("Curchod"). Claim 19 stands rejected under § 103(a) as obvious over Naka, U.S. Patent No. Re. 35,314 ("Logg"); and either Stamper or Curchod.

OPINION

Rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the seven points of contention therebetween:

- nature of game
- analogousness of Curchod
- game location
- motivation to combine Naka, Stamper, and Curchod
- joint action of players
- completion of game
- cooperative actions.

A. NATURE OF GAME

"Reading Naka et al. at column 22, lines 65-68," (Examiner's Answer at 13), the examiner finds that the reference "meets appellants' definition of an adventure game." (*Id.*) The appellants argue, "[m]aze games and sports simulators are clearly NOT adventure games as that term is well known in the art." (Appeal¹ Br. at 25.) In addressing the point of contention, the Board conducts a two-step analysis. First, we construe claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious.

¹We rely on and refer to the substitute appeal brief, (Paper No. 17), in lieu of the original appeal brief. (Paper No. 15.), because the latter was defective. (Paper No. 16.) The original appeal brief was not considered in deciding this appeal.

1. Claim Construction

"Analysis begins with a key legal question -- *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, claims 1, 7, and 10 recites in pertinent part an "electronic adventure game." Giving the three claims their broadest, reasonable construction, the limitations require an electronic game involving an adventure.

2. Obviousness Determination

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1383, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ

459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)).

Here, "Naka et al. discloses a multi-player video game which has 'a cooperative mode' and a 'competition mode.'" (Appeal Br. at 8.) In playing the game, "[t]wo players . . . try[] to have their characters race through [a] playfield trying to accumulate points by surmounting obstacles, slaying enemies or gathering 'magical rings'. . . ." Col. 22, ll. 65-68. Because the video game involves surmounting obstacles, slaying enemies, or gathering magical rings, we find that it involves an adventure.

B. ANALOGOUSNESS OF CURCHOD

The examiner finds, "Curchod is a game utilizing video technology." (Examiner's Answer at 5.) The appellants argue, "a golf simulator is not analogous to a video game. None of the classes and subclasses in the classification or field of search in Naka et al. can be found in the classification or field of search in Curchod." (Appeal Br. at 13.)

"Whether a reference in the prior art is 'analogous' is a fact question." *In re Clay*, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992) (citing *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568 n.9, 1 USPQ2d 1593, 1597 n.9 (Fed. Cir.

1987)). Two criteria have evolved for answering the question: "(1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *Id.* at 658-59, 23 USPQ2d at 1060 (citing *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)).

Although "the diverse Patent [and Trademark] Office classification of the references to be some evidence of 'non-analogy,'" *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973), "[s]uch evidence is inherently weak," *In re Mlot-Fijalkowski*, 676 F.2d 666, 669 n.5, 213 USPQ 713, 715-16 n.5 (CCPA 1982), and "is of limited value." *Id.*, 213 USPQ 713, 715-16 n.5. We consider the aforementioned criteria to carry greater weight.

Here, regarding the first criterion, because the appellants' invention is "[a]n electronic game for multiple . . . players," (Spec. at 47), it is from the field of electronic games. For its part, Curchod discloses a "golf simulator system which . . . increases the speed at which two or more golfers can together play a simulated round of golf."

Col. 2, ll. 20-24. Because the reference's simulator is electronic and enables golfers to play an electronic game of golf, Curchod is also from the field of electronic games. Because the inventions of the appellants and the reference are from the field of electronic games, we find that Curchod is analogous art regardless of its classification.

C. GAME LOCATION

The examiner finds, "Stamper et al. teach a video display system having split screen means being responsive to playing field location means such that when playing token and game the control component 16 are within a preset range, the separate portions of the graphical display for the two are merged into a single portion of the graphical display, and when the two components' game locations (of playing token and control component) are outside the preset range, the graphical display for those two components is split into separate portions. . . ." (Final Rejection at 4.²) She further finds, "Curchod teaches a double position golf simulator with split screen means being responsive to player location means such that when two players' game locations are within a preset range (when their golf balls are near the same hole), the separate portions of the graphical display for the two players are merged into a single portion of

²"We advise the examiner to copy [her] rejections into [her] examiner's answers," *Ex parte Metcalf*, 67 USPQ2d 1633, 1635 n.1 (Bd.Pat.App.& Int. 2003), rather than merely referring to prior Office actions. (Examiner's Answer at 3.)

the graphical display, and when the two players' game locations are outside the preset range (when the golf balls are near different holes), the graphical display for the two players is split into separate portions. . . ." (*Id.*) The appellants argue, "the secondary references link the split screen mode to game token location rather than player location." (Appeal Br. at 12-13.)

1. Claim Construction

Here, claim 1 recites in pertinent part the following limitations:

player location means for associating a game location with each player such that as each player moves through said adventure game, each player's game location is updated; and . . . split screen means for dividing the graphical display into separate portions of each player, said split screen means being responsive to said player location means such that when two players' game locations are within a preset range, the separate portions of the graphical display for the two players are merged into a single portion of the graphical display, and when the two players' game locations are outside the preset range, the graphical display for the two players is split into separate portions.

Giving the claim its broadest, reasonable construction, the limitations require merging or splitting a display in response to a player's location in an electronic game.

2. Obviousness Determination

Stamper discloses "a computer program routine . . . used in a pinball video game." Col. 3, ll. 37-38. Players of the game manipulate "a control component (pinball

flipper)," (Appeal Br. at 8), to "interact[] with one or more playing tokens (pinballs)." (*Id.*) During play, a "main control program generates information related to playing token status and position. . . ." Col. 4, ll. 12-14. Because a player focuses on the location of his pinball during a game, using the pinball to earn points, we find that the location of the pinball during a game is his location in the game.

Furthermore, "[t]he main control program generates a display wherein that portion of the playing field including the plunger and flippers is always displayed along the bottom of the video display." Col. 3, ll. 38-42. The remainder of the display constitutes "a playing window," *id.* at ll. 43-44, that "scrolls along the playing field so that the ball on the playing field closest to the [plunger and flippers] is always visible." *Id.* at ll. 3-5. When the pinball is so near the bottom of the playing field that "the playing window is at its furthest position down in the playing field, e.g., adjacent the control component portion of the playing field," *id.* at 49-52, we agree with the examiner's finding that the display of the plunger and flippers is merged with the display of the playing window. Otherwise, the two displays are split. Because the display of the plunger and flippers and the display of the playing window is merged or split in response to the location of the pinball, we find that Stamper merges or splits a display in response to a player's location in an electronic game.

For its part, Curchod's "golf simulator system includes a tee area . . . split into a first portion occupied by a first right-handed golfer. A second portion of the golf tee area is occupied by a second, right-handed golfer who can play independently or concurrently with the golfer on the same or separate simulated holes." Col. 2, ll. 34-39. "Ball flight sensing means sense the flight of each of two independently hit golf balls, one ball having been hit by the first golfer and the second ball having been hit by the second right-handed golfer." *Id.* at ll. 39-42. "A computer concurrently computes the flight and landing location of the first golf ball on a simulated first hole and the flight and landing location of the second golf ball on the simulated same hole or a second hole. . . ." *Id.* at ll. 45-48. Because a player focuses on the location of his golf ball during a game, seeking to sink the golf ball in one of "18 holes," col. 1, l. 33, we find that the location of the golf ball during a game is his location in the game.

More specifically, the golf simulator system comprises "a dual-user golf-simulator booth 50. . . ." Col. 5, ll. 17-18. "Next to the far end wall 58 of the booth is a large vertical screen. . . ." *Id.* at ll. 34-35. "[W]hen both players are playing at approximately the same location on the simulated hole, for example, when both players are on the tee area," *id.* at ll. 35-40, "the image on the screen 80 is a single view of a particular hole on a golf course." *id.* at ll. 36-37. When "the players are playing at different locations on the same simulated hole, that is, at different distances from the

hole and at different angles with respect to the hole," col. 6, ll. 16-18, "[t]he projector 82 is displaying a split image on the screen 80. The left half-image 92 corresponds to the view from the location of the first golf ball being hit by the golfer 66. The right half-image 94 corresponds to the view from the location of the second golf ball being hit by the golfer 68." *Id.* at ll. 10-15. Because the display on the vertical screen is merged or split in response to the location of the golf balls, we find that Curchod merges or splits a display in response to players' locations in an electronic game.

D. MOTIVATION TO COMBINE NAKA, STAMPER, AND CURCHOD

Finding that "creating a better game with exciting graphics is key to success of [a] game," (Examiner's Answer at 6), the examiner asserts, "it would have been obvious . . . to combine Naka et al.'s [multiplayer electronic game] with Stamper et al.'s video display system or Curchod's double position golf simulator for a better multiplayer electronic games utilizing split screens." (Final Rejection at 5.) Although they do not contest that creating a better game with exciting graphics is key to success of a game, the appellants argue, "[i]f this were adequate evidence of incentive to combine references, virtually every invention which is better than the prior art would be obvious provided that all of the individual elements could be found in the prior art." (Reply Br. at 3-4.)

"The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). "[T]he question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)). "[E]vidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. . . ." *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617 (citing *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996); *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995)).

Here, we find that evidence to combine flows from the references themselves. Naka's adventure game "can operate in either a single screen mode or a split screen mode. In the single screen mode of operation, only a single playfield screen is displayed." Col. 5, ll. 29-32. "In [the] split-screen mode, two screens are displayed at a

time, one for a first video game character and another for a second video game character." *Id.* at ll. 34-37. Although the preferred embodiment of the reference does not select its screen mode in response to the locations of its players, the reference recognizes that "modifications to the preferred embodiment will be readily apparent to those skilled in the art, and [that] the generic principles defined [t]herein may be applied to other embodiments and applications. . . ." Col. 4, ll. 60-64.

As explained regarding the prior point of contention, Stamper merges or splits a display in response to a player's location in an electronic game. Furthermore, the reference discloses that its invention "increase[s] the realism of video games," col. 2, l. 27, and "increase[s] the ease and enjoyment of play. . . ." *Id.* at ll. 29-30. Because Naka invites modifications to, other applications of, and other embodiments of its dual-mode, electronic adventure game; and Stamper's merging or splitting in response to a player's location in an electronic game increases the realism, ease, and enjoyment of electronic games; we are persuaded that the references would have suggested merging or splitting a display in response to a player's location in the electronic game.

As also explained regarding the prior point of contention, Curchod merges or splits a display in response to players' locations in an electronic game. Furthermore, the reference discloses that its invention "increase[s] player throughput and efficient

utilization of space, while still maintaining the quality of play." Col. 2, ll. 15-17.

Because Naka invites modifications to, other applications of, and other embodiments of its dual-mode, electronic adventure game, and Curchod's merging or splitting a display in response to a player's location increases player throughput and utilization of space, while still maintaining quality of play, we are persuaded that the references would have suggested merging or splitting a display in response to a player's location in the electronic game. Therefore, we affirm the obviousness rejection of claim 1.

E. JOINT ACTION OF PLAYERS

"[T]o assure separate review by the Board of individual claims within each group of claims subject to a common ground of rejection, an appellant's brief to the Board must contain a clear statement for each rejection: (a) asserting that the patentability of claims within the group of claims subject to this rejection do not stand or fall together, and (b) identifying which individual claim or claims within the group are separately patentable and the reasons why the examiner's rejection should not be sustained." *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (citing 37 C.F.R. §1.192(c)(7) (2001)). "If the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim." *Id.*, 63 USPQ2d at 1465.

Here, although the appellants allege, "[t]he rejected claims do not stand or fall together," (Appeal Br. at 7), they fail to satisfy the second requirement for certain claims. Specifically, the appellants argue claims 2, 3, and 5 as group, (*id.* at 15); claims 4 and 15 as group, (*id.* at 15); and claims 8, 11, and 13 as a group. (*Id.* at 20.) Furthermore, they do not argue the patentability of claim 16 separately. Therefore, claims 3 and 5 stand or fall with claim 2; claim 15 stands or falls with claim 4; claims 11 and 13 stand or fall with claim 8; and claim 16 stands or falls with claim 14.

With this representation in mind, we focus on the points of contention between the examiner and the appellants. The examiner finds, "Naka et al. further requires two players to act jointly with each other at certain points in said game when one player drops behind (Naka et al., 20:35-40), or when exchanging by teleport box in the competitive mode (Naka et al.'s Figs. 41, 42, 44, and 45)." (Examiner's Answer at 8.) The appellants argue, "[n]owhere in Naka et al. is there any requirement for joint action." (Reply Br. at 6.) They further argue, "[t]here is no suggestion in Naka et al. that any type of 'cooperative mode' be employed while in a split screen mode." (Appeal Br. at 17.) The appellants also argue, "there is only one cooperative mode action in Naka et al. and it is not related to any particular point in the game." (*Id.* at 21.)

1. Claim Construction

Claim 2 recites in pertinent part the following limitations: "requiring said at least two players to act jointly with each other at certain points in said game." Claims 7 and 20 include similar limitations. Claim 10 recites in pertinent part the following limitations: "game logic which provides opportunities for each player to act . . . jointly with the other player at different points in said adventure game. . . ." Giving the four claims their broadest, reasonable construction, the limitations either allow or require joint action during the game.

Claim 4 recites in pertinent part the following limitations: "said joint action means requires said at least two players to act jointly in separate locations while said split screen means divides the display into separate portion for each player." Giving the claim its broadest, reasonable construction, the limitations require joint action while the display is split.

Claim 8 recites in pertinent part the following limitations: "said game logic requires the players to act jointly in different ways at different points in said game." Giving the claim its broadest, reasonable construction, the limitations require different joint action at different points in the game.

Claim 14 recites in pertinent part the following limitations: "dividing the graphical display into separate portion for each player at some points in said game and for merging the display into a single portion for both players at other points in said game."

2. Obviousness Determination

As mentioned regarding the first point of contention, Naka "has two modes of operation: a cooperative mode and a competitive mode." Col. 18, l. 69 - col. 19, l. 1. The cooperative mode allows joint action during a game. More specifically, "[i]n the cooperative mode, the first character responds to inputs applied to the first controller, and the second character follows the first character through the playfield. It can be said that the two game characters cooperate in that the first character leads the second character through the playfield. Not only does the second character follow the first character, but the second character also imitates the first character's movements. Thus, the first and second game characters both respond to inputs provided to the first controller with the second character following behind and seeming to imitate the first character." Col. 19, ll. 1-13.

The reference requires joint action if "the second character falls a prescribed distance behind the first character, such as so far behind as to not be visible on the screen. . . ." Col. 20, ll. 37-39. "[T]hen the system will cause the second character to

catch up with the first character, and the system will again revert to the cooperative mode." *Id.* at ll. 39-42. Because players may select the cooperative mode wherein their characters act jointly, viz., the first character leads the second character, and the game requires use of the mode when one character falls far behind the other character, we find that Naka allows or requires joint action during a game. Therefore, we affirm the obviousness rejection of claim 2; of claims 3 and 5, which fall therewith; of claim 7; and of claim 10.

"Referring to the illustrative drawings of FIG. 41, [Naka] show[s] a split screen display with the top screen illustrating a first character in playfield region A and a bottom screen region with a second character in playfield region B." Col. 23, ll. 6-10. "Within the playfield there is an exchange object which we will refer to as a teleport box. When one of the character sprites comes to within a prescribed proximity of the exchange object, the positions of the two characters in the playfield and much of their status information is exchanged. In this manner, a character that has fallen behind can interchange playfield positions with another character." *Id.* at ll. 11-18. We agree with the examiner's finding that "[j]oint action is required in that neither player can refuse to swap, i.e., both players must participate. The triggers for the swaps are located at separate locations in the split screen mode." (Examiner's Answer at 8.)

Because players act jointly in using the teleport box while the screen is split, we find that Naka requires joint action while the display is split. Therefore, we affirm the obviousness rejection of claim 4 and of claim 15, which falls therewith.

We agree with the examiner's explanation that "Naka et al. [discloses] two types of 'joint action,' one in the 'cooperative mode' with merged screen and one with position exchange during split screen." (Examiner's Answer at 10.) We also agree with her finding that "these are different joint actions at different points of the game." (*Id.*) Because the game requires that the first character leads the second character when one character falls far behind the other character, and the players also act jointly in using the teleport box while the screen is split, we find that Naka requires different joint action at different points in the game. Therefore, we affirm the obviousness rejection of claim 8 and of claims 11 and 13, which fall therewith.

We agree with the examiner's finding that "Naka . . . at least splits at the point of the game for competition, and merges at the point of the game where a player falls behind. These points occur at different scenes or at parts of the game which require different actions." (Examiner's Answer at 11.) Therefore, we affirm the obviousness rejection of claim 14 and of claim 16, which falls therewith.

F. COMPLETION OF GAME

The appellants argue claims 6, 9, 12, and 17 as group. (Appeal Br. at 18.) Furthermore, they do not argue the patentability of claim 21 separately. Therefore, claims 9, 12, and 17 stand or fall with representative claim 6, and claim 21 stands or falls with claim 20.

The examiner finds, "[i]f players are in Naka et al.'s cooperative mode, it necessarily follows that player one cannot complete the game without player two completing the game. . . ." (Examiner's Answer at 9.) The appellants argue, "[a]lthough Naka et al. prevents a novice player or an inattentive player from losing by a wide margin, it certainly allows only one player to win." (Appeal Br. at 18.)

1. Claim Construction

Claim 6 recites in pertinent part the following limitations: "no player can complete the game without all players also completing the game." Claim 20 includes similar limitations. Giving the claim its broadest, reasonable construction, the limitations require that no player can complete the game without the other player also completing the game.

2. Obviousness Determination

Contrary to the appellants' argument, the limitations do not preclude a player from winning. For its part, Naka discloses that "[t]he player whose character crosses the largest chunk of playfield or accumulates the most points wins." Col. 22, l. 68 - col. 23, l. 2. Once a player wins, the game is over for both players. Because the adventure game is over for both players simultaneously, we find that no player can complete the game without the other player also completing the game. Therefore, we affirm the obviousness rejection of claim 6; of claims 9, 12, and 17, which fall therewith; of claim 20; and of claim 21, which falls therewith.

G. COOPERATIVE ACTIONS

The examiner finds, "[t]he cooperative following of player two in the cooperative mode clearly meets the limitation 'one player operating on a first object before the other player operates on said first object.'" (Examiner's Answer at 12.) He further finds, "Logg clearly teach players sharing limited resources (11:64-65), and further, acting cooperatively to defense each other from monster and overcome challenges (11:54-12:20)." (*Id.* at 13.) The appellants argue, "Logg [does not] require any of the actions listed in claim 19." (Appeal Br. at 26.)

1. Claim Construction

Claim 18 recites in pertinent part the following limitations:

at least one cooperative action selected from the group consisting of both players operating on the same object at the same time, each player operating on a different object at the same time, one player operating on a first object before the other player operates on said first object, one player accomplishing one task while the other player accomplishes another task, one player accomplishing a first task before the other player accomplishes a second task.

Giving the claim its broadest, reasonable construction, the limitations require one of the following cooperative actions:

- two players simultaneously operating on the same object
- two players simultaneously operating on different objects
- a player operating on an object before the other player operates thereon
- a player accomplishing a task while the other player accomplishes another task
- a player accomplishing a task before the other player accomplishes another task.

For its part, claim 19 recites in pertinent part the following limitations: "at least one cooperative action selected from the group consisting of holding a door for a player, handing a tool to a player, giving an item to a player, helping a player lift an object."

Giving the claim its broadest, reasonable construction, the limitations require one of the following cooperative actions:

- holding a door for a player
- handing a tool to a player
- giving an item to a player
- helping a player lift an object.

2. Obviousness Determination

As mentioned regarding the fifth point of contention, in Naka's cooperative mode, "the second character follows the first character through the playfield." Col. 19, ll. 3-4. Because the first character leads the second character through the playfield, the first player's character traverses "a prescribed path through the playfield," *id.* at ll. 16-17, before the second player's character.

"Not only does the second character follow the first character, but the second character also imitates the first character's movements." *Id.* at ll. 7-9. "At one point [in the path], there is a trench. A platform (an 'event') moves back and forth across the trench. . . . [T]he character must jump onto the platform and ride the platform across the trench and then jump off the platform on the other side of the trench." *Id.* at ll. 21-24. In the cooperative mode, the first player's character would ride the platform to traverse the trench before the second player's character. Because the first player's character traverses a path or rides a platform before the second player's character

does, we find that the first player operating on the path or platform before the other player operates thereon. Therefore, we affirm the obviousness rejection of claim 18.

"In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would . . . have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Logg discloses "[a] multi-player, multi-character video game where the game rules force the players to cooperate. . . ." Abs., ll. 1-2. Although we agree with the examiner that reference "teach[es] players sharing limited resources . . . and further, acting cooperatively to defense each other from monster and overcome challenges," (Examiner's Answer at 13), the examiner does not allege, let alone show, that Logg requires holding a door for a player, handing a tool to a player, giving an item to a player, or helping a player lift an object. Absent a teaching or suggestion of one of

these specific actions, we are unpersuaded of a *prima facie* case of obviousness.

Therefore, we reverse the obviousness rejection of claim 19.

CONCLUSION

In summary, the rejection of claims 1-18, 20, and 21 under § 103(a) is affirmed. The rejection of claim 19 under § 103(a), however, is reversed.

"Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences. . . ." 37 C.F.R. § 1.192(a). Accordingly, our affirmance is based only on the arguments made in the briefs. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).



Joseph Luggiero
JOSEPH LUGGIERO

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

LANCE LEONARD BARRY
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

Appeal No. 2003-1371
Application No. 09/186,856

Page 28

GORDON & JACOBSON, P.C.
65 WOODS END ROAD
STAMFORD, CT 06905